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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,574	09/22/2003	Kazuo Takaoki	2185-0706P	6442

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EXAMINER

LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,574

Applicant(s)

TAKAOKI, KAZUO

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a response filed on June 13, 2005. Applicants have added new claim 12. Presently, claims 1-12 are pending.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogane (U.S. 2002/0143124) for the same reasons set forth in the previous office action.

Briefly, Ogane teaches a modified particle prepared by a process comprising contacting a particle with a compound represented by the formula $M^1L_m^1$ and a compound represented by the formula R^1T . Specifically, M^1 is a bismuth atom (paragraph [0035], line 9). Element T represents an atom from group XV or XVI, and R^1 is an electron withdrawing group such as a halogenated hydrocarbon group, *inter alia* (paragraph [0052]). Specifically, T is an oxygen atom (paragraph [0047], line 9).

The order of contact of components (a), (b), (c), and (d) is not particularly restricted. In one manipulation, substances (a) and (b) are contacted with particle (d), followed by contact with (c) (see paragraph [0091]). Other permutations are disclosed in paragraphs [0089] and [0092] to [0101].

A further aspect of the invention is a catalyst comprising the modified particle. In this case, the modified particle is contacted with an aluminoxane and a transition metal component (claims 6 and 7). Group 4 metallocenes are exemplary (paragraph [0174]). Finally, the invention of the prior art is also drawn to a process for producing addition polymer using the catalyst described therein (claims 8, 11, and 12). The addition polymer is derived from olefins (paragraph [0219]), and the latter includes copolymers of ethylene with α -olefins (paragraph [0220] and [0221]).

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3. Claims 1-12 are rejected under 35 U.S.C. 102(a) as being anticipated by Ogane (DE 101 64 188) for the same reasons set forth in the previous office action. Since the German patent is essentially the same as the U.S. reference, the basis of the rejection is the same as that elucidated in the previous paragraph, and need not be repeated here.

Response to Arguments

4. Applicants traverse the rejection of claims over Ogane. Applicants' arguments have been considered fully, but they are not persuasive. Applicants' argument hinges on the notion that Ogane teaches use of water in making the modified particle, and since the present claims exclude use of water as a component, they would not be anticipated by Ogane.

An analysis of the prior art is instructive. Ogane teaches preparing a modified particle by contacting three compounds (a) $M^1L^1_m$, (b) $R^1_{t-1}TH$, and (c) $R^2_{t-2}TH_2$ with particle (d). As shown above, Ogane teaches that component (a) includes bismuth compounds. Ogane's component (b) has the same general formula as that of Applicant's component (b), $R^1_{t-n}TH_n$, because the claim states that n does not equal 2. An extensive listing of candidates for component (b) may be found in paragraphs [0064] to [0068]. These compounds fall in the general category of alcohols, amines, phenols, and possibly thiols. *Water is conspicuously absent in the listing.* Therefore, Applicants' claim that their compound $R^1_{t-n}TH_n$ is equated with Ogane's aqueous component is erroneous. In conclusion, then, components (a) and (b) of the instant claims are disclosed adequately in the prior art.

That Ogane teaches use of water has not been disregarded. Applicants' use of the term "comprising" in claim 1 would not exclude any unrecited elements. As such, the process set forth in the instant claims is met by the teachings of the prior art. The subject matter of claim 12 also lies within the purview of Ogane. Note that Ogane teaches a process in which substances (a) and (b) are contacted with particle (d), followed by contact with (c) (see paragraph [0091]). In this case, the process is comprised of a step that consists essentially of contacting (a) and (b) with particle (d). The term "comprising" would not exclude the step of contacting the resulting material with (c). As such, claim 12 remains anticipated by the prior art.

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Applicants declaration under 37 C.F.R. § 1.132 has been studied carefully. The examiner appreciates the nature and purpose of the experiments, and agrees with Applicants' conclusions drawn from the results presented therein. However, the evidence of secondary considerations such as unexpected results can not be used to overcome a rejection based on 35 U.S.C. 102. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA, 1973).

In light of this and previous discussions, the rejection of record has not been withdrawn.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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August 16, 2005



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